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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Shaughnessy et al.

Serial No: 09/491,982

Filed: January 27, 2000

For: OSTEOPOROSIS TREATMENT



Attorney Docket No. MDSP-P02-180

Art Unit: 1646

Examiner: Mertz, P.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

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REPLY TO RESTRICTION REQUIREMENT

Sir:

This response is filed in reply to the outstanding Restriction Requirement, mailed May 16, 2003, in connection with the above application. Applicants hereby elect Group IV, claims 1-3, and 14-18 (drawn to "a method for inhibiting reduction of bone density by administering an IL-11R antibody"), *with traverse*, on the following grounds.

Applicants traverse this restriction requirement on the basis that all listed Groups are so closely related and they share common features that would facilitate searching all groups at once. In fact, certain Groups overlap in claim scope, see, for example, Groups I, III, and IV all contain claims 14 and 15. In addition, Applicants also respectfully traverse the Examiner's contention that "the novelty of the inventions lying in the products being administered and not the process."

Applicants submit that the novelty of the claimed invention partly rests on the unexpected discovery that disrupting the IL-11/IL-11R/gp130 complex increases bone formation while decreases bone loss. Therefore, a search and examination of all pending claims based on this novel

feature can be made without imposing additional serious burden on the Examiner. Accordingly, reconsideration and withdrawal of the restriction between the Groups are respectfully requested.

Furthermore, Applicants submit that the instant Office Action is fashioned as a Group election, while species election appears to be appropriate. Particularly, Groups I-IV all encompass claims 1-3, which are generic claims linking elected and non-elected species. Pursuant to MPEP 809.04, "[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim." Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (MPEP 809.02(a)).

In addition, the burden is on the Examiner to examine these generic claims 1-3 throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.



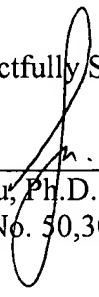
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Date: June 16, 2003

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Respectfully Submitted,



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